Reply Brief
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Dated: 28 JULY 2010 Signature: /Allen E. White/
(Allen E. White)

Docket No.: HO-P03493US0
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mrugesh Shah

Application No.: 10/776,711 Confirmation No.: 3444

Filed: February 12, 2004 Art Unit: 1637

For: Microbiological Method for Producing Petroleum Hydrocarbons from Solid Fossil Fuels Oil Tars and Products of Biological Examiner: M. Staples

REPLY BRIEF

This Reply Brief contains the following as required by 37 CFR 41.37(c)

(A) Identification page setting forth the appellant's name(s), the application number, the filing date of the application, the title of the invention, the name of the examiner, the art unit of the examiner and the title of the paper (i.e., Reply Brief), page 1;

(B) Status of claims, page 2;

(C) Grounds of rejection to be reviewed on appeal, page 3; and

(D) Argument, pages 4-8.

STATUS OF CLAIMS

An amendment after final rejection filed 17 July 2009 has been entered upon by the Examiner. Claims 2, 4-8, 10 and 16 were canceled during prosecution. Claims 1, 3, 9, 11-15, 17 and 18 are pending, stand rejected and are all subject of the appeal.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Rejection of claims 1, 3, 9 and 11-18 as failing to comply with the enablement requirement of the first paragraph of 35 U.S.C. 112.

ARGUMENTS

LEGAL STANDARD

The Examiner has erroneously rejected Applicant's claims as nonenabled by applying a standard requiring commercially viable industrial production. MPEP § 2164; *CFMT, Inc. v. YieldUP International Corp.*, 349 F.3d 1333, 1338 (Fed. Cir. 2003). The Examiners, faced with justifying their position, engage in a revisionist whitewashing of the pending rejection.

> Appellant appears to have misinterpreted Examiner's Enablement rejection in assertions that commercial success and industrial scale production are requirements of the rejection. Examiner makes no requirements of commercial success or industrial production. It is simply that in the art of petroleum and coal production, commercial success and industrial production are obvious goals. This is true as well for the related art of biofuel production.

Examiner Answer, page 20, Section A., second full paragraph. The enablement rejection on appeal derives from the original office action and has been maintained in substance throughout the lengthy prosecution. Indeed much of the text of the Examiner's Answer has perpetuated *verbatim* from the original Action. Applicant has not "misinterpreted" the Examiner's underlying thesis. The Examiner's erroneous legal standard has been made exceedingly clear. For example, from the 11 June 2008 Final Action alone, the Examiner justified the rejection and the art relied upon on such grounds as:

Applicant initially argues that the problems encountered in "commercially viable biofuel production" have no bearing on enablement of the instant claims. (Biofuel and fuel are interchanged throughout the following discussion.) First, the claims do not exclude "commercially viable biofuel production" which the instant specification attempts to achieve (see p. 6 lines 5-8). Thus such production is relevant to the instant claims.

Page 4, section 7., 2nd para.

Additionally, the instant specification admits that to produce the claimed microorganism to produce fuel would only be an "attempt" as follows.

> "Following isolation of target sequences using subtractive hybridization, they could also be directly transfected into a host microorganism, using conventional techniques, ***to attempt*** to produce a microorganism capable of producing petroleum from solid fossil fuels in a highly efficient, commercially viable manner" (emphasis by Examiner, see p. 6 lines 5-8).

The specification does not provide that the microorganism will be achieved. Note also that the specification is clearly directed to producing fuels: ". . . in a highly efficient, ***commercially*** viable manner" (emphasis by Examiner).

Page 12, final three paragraphs. The Examiner quite literally put emphasis on the Examiner's requirement that Applicant had to have a biosynthetic petroleum factory shipping to refineries. The Examiners now expound that the references relied upon are used for contents unrelated to commercialization issues. Applicant has addressed the fallacy of these contentions in the Appeal Brief. However the need look no further than the Examiner's own description of the art (11 June 2008,

Final Action):

Zaldivar et al.

As already noted above the claims do recite the limitation of "commercial production" and thus prior art which addresses commercial production is relevant to the instant claims. The claims also recite production of fuel (see for example, claim 12) and "Fuel ethanol production" is the subject of the reference by Zaldivar et al. (see Title).

Page 6.

Jeffries et al.

Applicant again argues that commercial applications are not relevant to the instant claims but such are relevant and especially relevant to instant claim 16.

Lin et al.

Examiner does not agree with Applicant's interpretation that Lin et al. enable fuel production from lignocellulose. Lin et al. conclude that "optimism is high" for such production and that Sweden "could" (and not "has") become self sufficient from such production. Applicant again argues that commercial applications are not relevant to the instant claims but such are relevant and especially relevant to instant claim 16.

Page 7. Lin et al, is particularly telling. Applicant pointed out that the Examiner's thesis was flawed in factual basis as well as law because commercially viable fuel ethanol production had in fact been achieved. The Examiner literally refused to concede even this much because the nation of Sweden had not yet become self sufficient from lignocellulose based ethanol production.

As amply evidenced by the above slice of the prosecution history, the Examiner has required a very high standard of actual and economically feasible industrial production. MPEP § 2164; *CFMT, Inc. v. YieldUP International Corp.*, 349 F.3d 1333, 1338 (Fed. Cir. 2003). Clearly, the co-signing Examiner's have realized the impropriety of this approach and have done an admirable job of presenting the rejection to the Board as something appearing legal. However, it is the same rejection base on the same art and suffering the same fundamental legal (and factual) flaws. The rejection should be reversed.

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Respectfully submitted,

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